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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/772,025	02/03/2004	Hank Risan	MOMI-025	5340

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EXAMINER	
MOORTHY, ARAVIND K	

ART UNIT	PAPER NUMBER
2431	

MAIL DATE	DELIVERY MODE
01/16/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/772,025	RISAN ET AL.	
	Examiner	Art Unit	
	ARAVIND K. MOORTHY	2431	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 October 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-35* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-35* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *03 February 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This is in response to the arguments filed on 21 October 2008.

2. Claims 1-35 are pending in the application.

3. Claims 1-35 have been rejected.

Response to Arguments

4. Applicant's arguments filed 21 October 2008 have been fully considered but they are not persuasive.

On page 9, the applicant argues that the application was filed on 2/3/2004 and as such could reasonably be expected to cover versions of the claimed matter that were either operational or available on that date such as backward compatibility. Further, the inventive aspects would clearly be expected to cover any versions that would reasonably enable one of skill using the detailed description of the instant disclosure without undo experimentation.

The examiner respectfully disagrees. The applicant's remarks are just a general allegation indicating that all types of versions are applicable to the claimed trademarks. The applicant makes a mere allegation that "could reasonably be expected to cover versions of the claims matter that were operational or available on that date such as backward compatibility." If this is the case, which versions were known to the applicant at the time of filing of the instant application? The applicant has failed to specifically identify which version of iTunes™ and iPod™ was known to the applicant at the time of filing of the instant application since versions of iTunes™ and iPods™ are known to constantly change over time. The applicant's specification fails to define any specific

version or type of iPod™ and iTunes™. Similarly, no specific version of windows operating system or Mac™ operating system has been identified by the applicant, nor are they described in the applicant's specification. The claims contain the trademark/trade name iTunes™, iPod™, Windows™, and Macintosh™. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See Ex parte Simpson, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe operating system and media player types and, accordingly, the identification/description is indefinite. The comments made by the applicant are not satisfactory in order to overcome the rejection under 23 USC 112 2nd paragraph. The examiner requested specific evidence as to what version and/or types are relevant to the trademark terms and the applicant has failed to provide that evidence. The rejection is hereby maintained by the examiner.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 2, 4-10, 13, 15, 16, 18-20, 22, 23, 25-31 and 34 contain the trademark/trade name iTunes, iPod, Macintosh and Windows. However, the applicant has not specified which version of iTunes is being claimed. The applicant has not specified which model of iPod is being claimed. The applicant does not specify which version of the Macintosh and Windows operating system is being claimed. The examiner asserts that there were various versions of iTunes and Macintosh and Windows operating systems available at the time of filing of the current application. The examiner asserts that there were different models of the iPod available at the time of filing of the current application.

Any claims not directly addressed are rejected on the virtue of their dependency.

Allowable Subject Matter

6. Claims 1-35 would be allowable if rewritten or amended to overcome the rejection under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action

Prior art does not disclose, teach or fairly suggest controlling a data output path carrying media content of a client system with a compliance mechanism by diverting a

commonly used data pathway of a media content presentation application to a controlled data pathway monitored by the compliance mechanism.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ARAVIND K. MOORTHY whose telephone number is (571)272-3793. The examiner can normally be reached on Monday-Friday, 8:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz R. Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Aravind K Moorthy/
Examiner, Art Unit 2431

/Christopher A. Revak/
Primary Examiner, Art Unit 2431